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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,792

07/16/2004

Michael John Sleeman

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6909

7590

12/29/2006

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/29/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/501,792	<b>Applicant(s)</b> SLEEMAN ET AL.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-36 is/are pending in the application.
- 4a) Of the above claim(s) 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/16/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Claims 19-36 are pending in the application, claims 32-36 are withdrawn from consideration. Claims 1-18 have been cancelled.
2. Amendments to claims in the preliminary amendment, filed on July 16, 2004, have been entered in the above-identified application.

#### ***Election/Restrictions***

3. Applicant's election with traverse of Group I, claims 19-31, in the reply filed on October 9, 2006 is acknowledged. The traversal is on the ground(s) that EP 0225103 does not render the claims unpatentable. This is not found persuasive because for the reasons presented below in the 102 rejection section.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 32-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 9, 2006.

#### ***Specification***

5. The disclosure is objected to because of the following informalities: the specification lacks section heads. See MPEP § 601 for the preferred form and content of an application.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “of the kind referred to in” in claim 19 is unclear and renders the claim vague and indefinite. The addition of the word “kind” to an otherwise definite expression extends the scope of the expression so as to render it indefinite. Furthermore, this expression implies that the limitations following the phrase are optional, since it only has to be of the “kind” not exactly.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 19-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Balley et al. (EP 0 225 103).

Regarding Applicant’s claim 19, Balley discloses a retroreflective material comprising a coating and a plurality of beads (*figure 5*). The coating is applied to at least a portion of the plurality of the beads (*page 5, line 26 and figure 5*). The coating is deemed to produce or enhance retroreflectivity of the beads and which bridges at least some of gaps between the

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plurality of beads, and the coating discontinuous which produces areas of contrast (*figure 5*).

Thus, the contrast is areas with the coating and areas without the coating.

The limitation “the coating being treated and/or removed to produce areas of contrast” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Balley discloses a discontinuous coating.

Regarding Applicant’s claim 20, Balley disclose the discontinuous coating is deemed to represent a pattern (*figure 5*).

Regarding Applicant’s claim 21, Balley discloses that the coating bridging is substantially removed from the gaps between the beads (*figure 5*).

Regarding Applicant’s claims 22 and 23, Balley’s retroflective sheeting is deemed to be in the form of a tap or sheet since it meets all the limitations of the claim (*title and figure 5*).

Regarding Applicant’s claim 24, Balley discloses that the coating is discontinuous in a way to expose the underlying substrate (*figure 5*).

Regarding Applicant’s claim 25, Balley discloses that the underlying substrate is colors (*page 5, lines 41-44*).

Regarding Applicant’s claims 26 and 27, the limitations “in which the areas of contrast are produced by chemical treatment of the coating” and “in which the chemical

treatment involves coloring of the coating” are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Balley discloses a discontinuous coating.

Regarding Applicant’s claims 28 and 29, Balley discloses that the coating is metal based (*page 5, line 26*). The limitation “in which the coating has been affected by metallization” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Balley discloses a metal coating.

Regarding Applicant’s claims 30 and 31, Balley discloses that the coating comprises a medium containing elements importing retreflectivity, such as metal flakes (*page 5, line 26*).

10. Claims 19-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bingham (US Patent No. 4,763,985).

Regarding Applicant’s claim 19, Bingham discloses a retroreflective material comprising a coating and a plurality of beads (*figure 4*). The coating is applied to at least a portion of the

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plurality of the beads (co. 8, *lines 9-11 and figure 4*). The coating is deemed to produce or enhance retroreflectivity of the beads and which bridges at least some of gaps between the plurality of beads, and the coating discontinuous which produces areas of contrast (*figure 4*).

Thus, the contrast is areas with the coating and areas without the coating.

The limitation “the coating being treated and/or removed to produce areas of contrast” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Bingham discloses a discontinuous coating.

Regarding Applicant’s claim 20, Bingham discloses the discontinuous coating is deemed to represent a pattern (*figure 4*).

Regarding Applicant’s claim 21, Bingham discloses that the coating bridging is substantially removed from the gaps between the beads (*figure 4*).

Regarding Applicant’s claims 22 and 23, Bingham’s retroflective sheeting is deemed to be in the form of a tap or sheet since it meets all the limitations of the claim (*title and figure 4*).

Regarding Applicant’s claim 24, Bingham discloses that the coating is discontinuous in a way to expose the underlying substrate (*figure 4*).

Regarding Applicant’s claim 25, Bingham discloses that the underlying substrate is colors (*col. 2, lines 35-36*).

Regarding Applicant's claims 26 and 27, the limitations "in which the areas of contrast are produced by chemical treatment of the coating" and "in which the chemical treatment involves coloring of the coating" are method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Bingham discloses a discontinuous coating.

Regarding Applicant's claims 28 and 29, Bingham discloses that the coating is metal based (*col. 2, lines 41-43*). The limitation "in which the coating has been affected by metallization" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Bingham discloses a metal coating.

Regarding Applicant's claims 30 and 31, Bingham discloses that the coating comprises a medium containing elements imparting retroreflectivity, such as metal flakes (*col. 2, lines 41-43 and col. 8, lines 9-11*).



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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490.

The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

12/26/06

ALICIA CHEVALIER  
PRIMARY EXAMINER

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